

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-3 and 6-14 are pending; Claims 9 and 10 were previously withdrawn from consideration. No claims are newly added, canceled, or amended herewith.

In the outstanding Office Action, Claims 1-3, 6-8, and 11-14 were rejected under 35 U.S.C. § 103(a) as unpatentable over McGuire et al. (U.S. Pat. No. 6,254,965, hereafter McGuire) in view of the Akahori et al. (U.S. Pat. No. 5,310,587, hereafter Akahori) and Asahi (JP 404154579A). For the reasons discussed below, this rejection is respectfully traversed.

Claim 1 relates to a kitchen sheet including a base sheet made of a fiber aggregate, the base sheet having a plurality of convex portions giving the kitchen sheet an apparent thickness of 1.0 mm or greater and a compressive recovery of 30% or more. As described in the specification, if the apparent thickness of the kitchen sheet is smaller than 1.0 mm, the passage ways for water vapor formed of concavities connecting with each other are narrow, and the drops of condensation on the kitchen sheet, into direct contact with food.<sup>1</sup>

As set forth in MPEP § 2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Additionally, “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.”

In the outstanding Office Action, the motivation to combine McGuire, Akahori, and Asahi is not found within the teachings of any of the references. In fact, Applicants

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<sup>1</sup> Specification, page 13, lines 10-15.

respectfully submit that it is only in light of teachings of the present specification that such a combination would become obvious.

“A patentable invention may lie in the discovery of the source of the problem even though the remedy may be obvious [something that is not admitted in this case] once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” In re Sponnoble, 405 F.2d 578, 585, 160 U.S.P.Q. 237, 243 (CCPA 1969).

In this case, although a kitchen sheet may be shaped or sized in numerous ways, Applicants discovered (as noted above) that if the apparent thickness is smaller than 1.0 mm, the passageways formed by convex portions are too small to effectively vent water vapor generated from food being heated. As a result, undesirable condensation forms on the kitchen sheet during heating. Furthermore, because the sheet has a specific compressive recovery (i.e., a compressive recovery of 30% or more, as recited in Claim 1) the convex portion are less likely to collapse due to food weight, securing the passageways been the convex portion.

Additionally, as is evident from the Applicants’ disclosure, to assert that the proposed modification of McGuire would only involve a mere change in the size motivated by the desire to increase absorbent capabilities and protection disregards the “as a whole” requirement set forth in MPEP § 2141.02. Accordingly, it is respectfully submitted that the applied combination of McGuire, Akahori, and Asahi is based upon hindsight reconstruction, and is impermissible. It is therefore respectfully requested that this rejection be withdrawn.

Moreover, the Office Action appears to take Official Notice at page 3 that the claimed compressive recovery is inherent in the modified version of McGuire. However, no references were cited to support this assertion. This violates the principles of MPEP § 2144.03, which states that: “while ‘official notice’ may be relied on, the circumstances

should be rare when an application is under final rejection.” Moreover, “the notice of facts beyond the record which may be taken by the Examiner must be ‘capable of such instant and unquestionable demonstration as defy dispute.’” In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

In this case, Applicants respectfully submit that the Official Notice taken in the outstanding Office Action is not capable of such instant and unquestionable demonstration as to defy dispute. Accordingly, if this Official Notice is to be maintained, it is respectfully submitted that a reference be cited in support of the assertion. Additionally, if the Official Notice is to be maintained, it is respectfully requested that the finality of the outstanding Office Action be withdrawn.

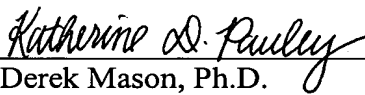
Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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